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REMARKS

Claims 1-8, 10-12, 14-19, and 23-27 are currently pending in the subject application and are presently under consideration. Claims 20-22 and 28-38 were previously withdrawn pursuant to a restriction requirement and are hereby cancelled. Claim 1 has been amended to incorporate suggestions provided by the Examiner in emails dated July 13, 2004 and September 27, 2004. Claims 23-27 have been amended to correct minor informalities and place the application in better form for appeal, if necessary. Claims 39-47 have been newly added herein to highlight various aspects of the invention neither disclosed nor taught by the cited references alone or in combination. No new matter has been added. Furthermore, applicants' representative notes for the record that two claims numbered 29 were originally submitted with this application both of which are cancelled herein. A complete listing of the claims showing changes made in accordance with 37 C.F.R. § 1.121 can be found at pages 3-10.

Changes to the specification have been made at page 2 to modify the title in accordance with the Examiner's objection and provided suggestion.

Finally, let it be noted that pursuant to an interview between Examiner Jeffrey A. Smith (acting supervisor for the art unit) and Mr. David W. Grillo on January 31, 2004, the Election of Species requirement, mailed on December 31, 2003, was removed thereby rendering moot applicants' provisional Election filed on January 30, 2004.

Favorable consideration of the subject patent application and entry of the provided amendments is respectfully requested in view of the comments herein.

I. Rejection of Claim 1, 8 and 14-16 Under 35 U.S.C. §103(a)

Claims 1, 8 and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406) in view of Kolawa, *et al.* (U.S. 6,236,974). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither O'Hagan, *et al.* nor Kolawa, *et al.* alone or in combination, teach or suggest all the limitations as recited by the subject claims.

09/490,529

645XX

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993) (emphasis added).

The subject invention discloses a personal shopping system. In particular, independent claim 1, as amended, recites ***one or more proximity sensors that monitor customer activity in product sales areas in the shopping establishment...the controller including at least one computer executable instruction that generates a theft condition upon expiration of a time period that starts after receipt of a signal from the proximity sensor***. O'Hagan *et al.* fails to disclose, teach or suggest these claim limitations. Rather, O'Hagan *et al.* relates generally to a customer information network for a retail store, a system for optically extracting indicia from a coupon, and employing the extracted indicia within the network to facilitate customer shopping. (See col 1, ln. 14-19). More specifically, O'Hagan *et al.* pertains to a portable computing device (*i.e.*, mobile terminal) that can assist the customer through the store for efficient shopping. "For example, the host computer can generate a map and protocol for the user to find the products desired without having to go back and forth through the store." (See col. 3, ln. 25-35). Moreover, O'Hagan, *et al.* merely discloses and teaches a proximity sensor that can detect the presence of the portable computing device. By detecting the portable computing device, the proximity sensor of O'Hagan, *et al.* can trigger the device display to show a web page relating to the sale of a product within the vicinity of the customer. (See col. 29, ln. 5-11). Hence, O'Hagan, *et al.* suggests a proximity sensor to track the movement of the

09/490,529

645XX

portable device within the establishment and to communicate shopping-related information to the customer. In contrast, the proximity sensor of the subject invention *monitors customer activity* in product sales areas independent of the location of the mobile device to ultimately *trigger theft conditions*. Accordingly, the teachings of O'Hagan, *et al.* would have failed to suggest the claimed limitations to a person of ordinary skill at the time the invention was made.

Kolawa, *et al.* fails to make up for the aforementioned deficiencies of O'Hagan, *et al.* Kolawa, *et al.* discloses a method and apparatus for automated selection and organization of products including menus. In particular, the cited reference relates to a computer system that will perform all of the selection and organization tasks involved with suggesting products to the user including menus for family meal planning. Kolawa, *et al.* is silent as to *one or more proximity sensors that monitor customer activity in product sales ... the controller including at least one computer executable instruction that generates a theft condition upon expiration of a time period that starts after receipt of a signal from the proximity sensor.*

As per claim 8, applicants' representative respectfully traverses the purported well known statements regarding a means for providing secure and silent communications when transferring data to and from the shopping terminal without notifying or disturbing a user and requests that the Examiner cite a reference in support of his position pursuant to MPEP 2144.03 if the rejection of this claim is to be maintained.

In view of at least the forgoing, it is respectfully submitted that neither O'Hagan *et al.* nor Kolawa *et al.*, alone or in combination, teach or suggest applicants' invention as recited by the subject claims. Withdrawal of the rejection of independent claim 1 (as well as claims 2, 8 and 14-16 depending directly or indirectly thereon) and issuance of a timely notice of allowance is respectfully requested.

II. Rejection of Claim 7 Under 35 U.S.C. §103(a)

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406) in view of Kolawa, *et al.* (U.S. 6,236,974), and further in view of purported old and well-known tools for computer applications. It is respectfully submitted that this rejection should be withdrawn for at least the following reason.

09/490,529

645XX

Claim 7 depends from claim 1. Claim 1 is allowable for at least the aforementioned reasons. By virtue of its dependency, claim 7 includes all the limitations of claim 1. Therefore, claim 7 is allowable for at least the same reasons as claim 1.

Furthermore, applicants' representative respectfully traverses the well known statements and requests that the Examiner cite a reference in support of his position pursuant to MPEP 2144.03 if the rejection of this claim is to be maintained.

Moreover, the fact, if it is a fact, that a processor could perform general conversions does not teach, alone or in combination with the cited references, a shopping terminal comprising a means for converting any currency amount to and from a corresponding Euro amount, as claimed.

III. Rejection of Claim 19 Under 35 U.S.C. §103(a)

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406) in view of Kolawa, *et al.* (U.S. 6,236,974) and further in view of Wren (U.S. 6,055,514). It is respectfully submitted that this rejection should be withdrawn for at least the following reason.

Claim 19 is allowable for at least the same reasons as claim 1 from which it depends. Accordingly, this rejection should be withdrawn and the claim allowed.

IV. Rejection of Claims 2, 10-12 and 17-18 Under 35 U.S.C. §103(a)

Claims 2, 10-12 and 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406) in view of Kolawa, *et al.* (U.S. 6,236,974) and further in view of Ruppert, *et al.* (U.S. 5,424,524). It is respectfully submitted that this rejection should be withdrawn for at least the following reason.

Claims 2, 10, 11, and 18 depend directly from claim 1. Claims 12 and 17 are dependent upon claim 1 indirectly through claims 11 and 14, respectively. By virtue of their dependencies on claims 1, claims 2, 10-12, and 17-18 include all the limitations of independent claim 1. Claim 1 is allowable in view of the comments *supra*. Accordingly, claims 2, 10-12 and 17-18 are allowable for at least the same reasons.

Furthermore, none of the cited references alone or in combination disclose teach or suggest a shopping terminal that comprises a scanning system comprising a *wearable*

09/490,529

645XX

computer processor and a wearable scanning device in communication with the computer processor, as recited by claim 11 and the scanning system further comprises a **headset having a speaker** and a miniature display device for providing a audio, graphical and video information, as recited by claim 12.

A prima facie case of obviousness is established by a showing of three basic criteria. First, *there must be some suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify the reference* or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference* (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As per claim 11, the Examiner contends that the fact, if it is a fact, that the device disclosed by Ruppert, *et al.* is light weight obviates claim 11 as it could be wearable. This is not the proper standard under which obviousness is determined. Disclosure concerning the weight of a device alone is not enough to teach or suggest a **wearable computer processor and a wearable scanning device**. Furthermore, the Examiner claims that Ruppert, *et al.* teaches a scanning system that comprises a **headset** having a speaker and a miniature display device for providing audio, graphical and video information, as recited by claim 12 (citing the abstract). However, Ruppert, *et al.* merely provides that the device provides audio feedback. There is no disclosure, teaching or suggestion of a headset as claimed. Accordingly, it is readily apparent that the limitations of claims 11 and 12 are not obvious in view of the cited art. Thus, the rejection thereto should be withdrawn.

V. Rejection of Claims 3-5 Under 35 U.S.C. §103(a)

Claims 3-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406) in view of Kolawa, *et al.* (U.S. 6,236,974) in view of Ruppert, *et al.* (U.S. 5,424,524), and further in view of Bianco (U.S. 5,047,614). It is

09/490,529

645XX

respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Claims 3-5 depend from and thus include all the limitations of claim 1. Claim 1 is allowable for at least the aforementioned reasons. Accordingly, claims 3-5 are allowable for at least the same reasons.

Furthermore, the references alone or in combination fail to disclose, teach or suggest at least two bar code activation buttons located on the two side surfaces of the housing ... whereby the user can view the display and the visible light source upon activation of either of the bar code activation keys, as recited in claim 3. The Examiner contends that Bianco teaches this limitation however Bianco merely discloses a power switch situated on the top of the scanning device. Such disclosure does not obviate the claimed limitation.

Furthermore, applicants' representative respectfully traverses the well known statement/Official Notice with respect to claim 5 and requests that the Examiner cite a reference in support of his position pursuant to MPEP 2144.03 if the rejection of this claim is to be maintained. In the absence thereof, this rejection should be withdrawn and allowed as the Examiner concedes that the cited references fail to disclose or teach an information key for allowing a user to display product information, as recited by claim 5.

VI. Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406) in view of Kolawa, *et al.* (U.S. 6,236,974) and further in view of Bianco (U.S. 5,047,614). It is respectfully submitted that this rejection should be withdrawn for at least the following reason.

Claim 6 depends from claim 1 and is allowable for at least the same reasons as claim 1. Hence, this rejection should be withdrawn and the claim allowed.

VII. Rejection of Claims 23-27 Under 35 U.S.C. §103(a)

Claims 23-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.* (U.S. 6,236,974) in view the Official Notice. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

09/490,529

645XX

Claim 23 has been amended to recite *monitoring customer activity* in product sales areas in the shopping establishment *via one or more proximity sensors coupled to the controller to trigger a theft condition*. Neither Kolawa, *et al.* nor the Official Notice alone or in combination disclose, teach or suggest these claim limitations. Accordingly, claim 23 (as well as 24-27 depending thereon) is allowable.

Moreover, applicants' representative respectfully traverses the well known statements and requests that the Examiner cite a reference in support of his position pursuant to MPEP 2144.03 if the rejection of the claims is to be maintained. Applicants' representative questions the accuracy of such broad statements concerning the business practices of several large companies (e.g., United Parcel Service, IKEA, Lens Crafter, Best Buy, Amazon.com) utilized in an attempt to obviate the claimed invention. Furthermore, even if the statements are accurate representations of the business practices applicants' representative doubts that all practices are sufficiently old to have been known prior to conception of the subject invention as claimed.

VIII. New Claims 39-47

Claim 39- 47 have been newly added herein. Claims 39-42 and claims 46-47 have been added to further and more clearly describe particular aspects of the subject invention. Claims 43-45 have been added to broaden the scope of the claims by incorporating subject matter believed to be allowable from the dependent claims into independent form. No new matter has been added. Accordingly, entry and allowance of new claims 39-47 is respectfully requested.

09/490,529

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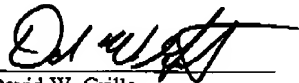
CONCLUSION

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063. Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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